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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91176744
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DC COMICS and
MARVEL CHARACTERS, INC.,

Opposers,

v.

MICHAEL CRAIG SILVER,

Applicant.

Opposition No. 91/176,744
Application No. 78/823,155
Mark: SUPER HERO

**OPPOSER'S REPLY BRIEF IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY
JUDGMENT**

Opposers DC Comics and Marvel Characters, Inc. (collectively, "Opposer") address the following issues raised in Applicant's Response to Opposer's Motion for Summary Judgment ("Applicant's Response Brief"):

I. APPLICANT'S STATEMENTS ARE WITHOUT THE SUPPORT OF DOCUMENTARY EVIDENCE AND IN CONTRADICTION TO APPLICANT'S DISCOVERY RESPONSES.

Applicant has failed to present *any* contemporaneous documentary evidence to corroborate his self-serving statements concerning his alleged *bona fide* intention to use the SUPER HERO mark in commerce at the time he filed his application. "[T]he absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence." *Honda Motor Co., Ltd. v. Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (precedential) (citation omitted).

In this case, Applicant does not seek to present facts which “explain or outweigh” his failure; rather, he claims to have put forth evidence sufficient to demonstrate a *bona fide* intent. However, the purported evidence in Applicant’s Response Brief is contradicted by his own sworn testimony. For example, Applicant makes the following assertion in his Response Brief:

“At the time of filing the Application, Applicant had created a business plan, had researched the basic information on the logistics of creating the proposed products, had conducted a market study and had several manufacturing contacts.”
See, Applicant’s Response Brief at p. 6.

Yet in Applicant’s own deposition testimony, he admitted that no market study or research for the SUPER HERO mark had ever been conducted; no marketing contacts had ever been made; and no basic information concerning the logistics of production had ever been researched. An example of Applicant’s contradictory deposition testimony is as follows:

Q. “Okay. Let’s go back to Exhibit 5, please, page 2, your response [to Interrogatory No. 19] reads ‘No market study by applicant or anyone acting on applicant’s behalf has ever conducted a market study, survey or opinion poll concerning SUPER HERO or Opposer’s marks’; is that correct?”

A. “That is what it reads.”

Q. “Is that still an accurate answer?”

A. “Yes it is.” *See*, Deposition of Michael Silver (“Silver Dep.”), 105:7-14, attached as Exhibit “A” to the Declaration of Jonathan D. Reichman (“Reichman Dec.”) submitted in support of Opposer’s Motion for Summary Judgment.

Q. “Okay. Prior to the February of 2006 filing date, had you conducted any studies or market research on--regarding manufacturing of similar products in Class 3?”

A. “No.” *See*, Silver Dep., 139:20-24.

Q. “And since 2006, have you done any of that, conducted any studies or market research?”

A. “No. []” *See*, Silver Dep., 140:1-3.

Q. “Okay. At the time you filed this application, in February of 2006, had you investigated the costs of manufacturing Class 3 products?”

A. “No. []” *See*, Silver Dep., 137:18-22.

Q. “Okay. And I take your answer to mean that prior to your filing date in February of 2006, you hadn’t investigated any business contacts with respect to manufacturing?”

A. “Well , again, in regards to the sequence of timeline, it was not necessary at that time.” *See*, Silver Dep. 139:11-15.

Q. “In the three years since you filed your intent to use application, have you made any business contacts in connection with anticipated manufacturing of the products?”

A. “Well, there’s been no need to, no need to, because I’m still absorbed in my time, in my schedule with addressing this opposition.” *See*, Silver Dep. at p. 138:23-139:4.

Furthermore, Applicant previously confirmed that he “has not taken any steps towards manufacturing, distributing, selling and/or promoting any products or services under the SUPER HERO trademark.” *See*, Applicant’s Amended/Supplemental Responses to Interrogatory Nos. 1-27 (“App. Supp. Interrog. Resp.”) at Resp. 27, attached to the Reichman Dec. submitted in support of Opposer’s Motion for Summary Judgment as Exhibit I.

In Applicant’s Response Brief, he asserts that “manufacturing contacts for *related businesses*. . . could be used to create *promotional apparel or stickers* for the sunscreen brand.” *See* Applicant’s Response Brief at p. 8 (emphasis added). However, Applicant has not applied to register the SUPER HERO trademark for either *apparel* or *stickers*. Rather, he has applied to register the mark for *skin care products*, and has failed to make a single manufacturing contact for the production of *these* complex goods.

Applicant’s Response Brief is replete with other self-serving and contradictory statements. The Board should ignore them, and instead look at the evidence submitted by Applicant (or lack thereof, as is the case here). “Evidence is objective. . . in the form of real life facts and by the *actions* of the applicant, not by the applicant’s testimony as to its subjective state of mind.” *See*, *J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition* § 19:14, at p. 19-40 (4th ed. 2004) (emphasis added). Applicant’s Response Brief amounts to mere

statements of subjective intention, and (aside from significant credibility issues) such statements, without more, are patently insufficient to establish a *bona fide* intention to use the mark in commerce. *See, Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

II. APPLICANT'S LATE-SUPPLIED DOCUMENTS ARE IRRELEVANT AND FAIL TO ESTABLISH A BONA FIDE INTENTION TO USE THE SUBJECT MARK.

In Applicant's Response Brief, Applicant provides three documents which he asserts evidence his *bona fide* intention to use the SUPER HERO mark. Preliminarily, Opposer notes the dubious origin of two of the documents (Exhibits "A" and "B"), in that they have never before been produced to Opposer.¹ Furthermore, these documents do not contain any dates to indicate when they were created. We are only vaguely told by Applicant that:

"The attached checklist was created years ago by the applicant for use by all of his business enterprises. However since it's [*sic*] creation, this business checklist was added for the specific purpose of aiding the development of his Super Hero Mark." *See*, Applicant's Response Brief at p. 6.

Applicant never states *when* the "checklist" was "added for the purpose of aiding the development" of the SUPER HERO mark. Applicant also fails to identify the exhibit which constitutes the "checklist." Most likely it is the document designated as "Exhibit A." "Exhibit A" contains a list of typed generic business terms, such as: "Business Cards," "Logos" and "Publish DBA." The term "Super H." is scribbled on the right side, and there is no indication when it was written there. Regardless, this document is so lacking in any relevant content that it

¹ On September 4, 2008, Opposer's Motion to Compel Discovery was granted in full by the Board. Thereafter, Applicant supplemented his discovery responses and confirmed that they were complete. Applicant's failure to produce these two documents is in violation of the discovery rules. *See* 37 CFR § 2.120(g)(1). "The sanctions which may be entered by the Board pursuant to Rule 2.120(g)(1) include striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters as evidence; and entering judgment against the disobedient party." *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1903 (TTAB 2008) (precedential) (party precluded from using evidence that was improperly withheld in defiance of a court-ordered motion to compel).

does not shed any light on the issue at hand. Furthermore, calling this skeletal list of a few generic business terms a “business plan” is preposterous.

Applicant’s Exhibit “B” consists entirely of a scrawl of handwriting which reads “Maiden Waves Sunscreen Formula”, and includes a sketch of an arrow pointing to the words “Super Hero Name.” It is not clear what this document represents, as Applicant has provided no information explaining its content. Presumably, Exhibit “B” is intended by Applicant to refer to the document that Applicant attached to his Brief and Response to Opposer’s Motion for Leave to Amend Its Notice of Opposition.² This document was not marked with an exhibit number, and was never produced to Opposer in discovery. For ease of reference, Opposer will call it “Document X.” This document contains what appears to be a list of ingredients, percentages, and various scientific terminology related to creation of sunscreen products under the “*Maiden Waves*” trademark. However, Applicant has no information regarding the creation date of “Document X.” *See*, Silver Dep., 61:5-62:18.

Moreover, during Applicant’s deposition, when questioned about the specifics of “Document X,” Applicant had no knowledge as to any of the information contained therein:

Q. “Is SPF an acronym?”

A. “I believe it is. I don’t remember what it stands for though.”

Q. “Sun protection factor ring a bell?”

A. “Sounds familiar.” *See*, Silver Dep., 63:24-64:3.

Q. “All right. So let’s look at intermittent blockage of ultraviolet radiation, I’m down in the bullet points here under Engineered Nano-Suntection SPF 55. The second to last bullet there is intermittent blockage of ultraviolet radiation, range 200 nanometers to 700 nanometers. What does that mean?”

A. “I think I probably got these bits and pieces of sunscreen description from a newspaper, maybe I was reading it. [].” *See*, Silver Dep., 65:3-12.

² In Applicant’s Response Brief, he refers to “the Maiden Waves formula description previously submitted.” *Ibid*, p. 8.

Q. "Do you know whether this range—there's this range 200 nanometers to 700 nanometers. Do you know whether that range accurately reflects wavelengths for all ultraviolet radiation?"

A. "I think it may have. []." See, Silver Dep., 66:1-5.

Q. "Okay. Would it surprise you to know that radiation—electromagnetic radiation that has a wavelength longer than 400 nanometers isn't ultraviolet?"

A. "Would it surprise me? Again, I'm not a chemist and not an engineer. []." See, Silver Dep., 66:15-19.

Q. "So now you've got a list of ingredients here and I know you said this isn't a recipe but you've got a list of chemicals here. Who prepared this list of constituent compounds?"

A. "Well, this was a list typed by me. []" See, Silver Dep., 67:10-15.

Q. "And I assume you decided on these percentages?"

A. "I don't think I decided. []." See, Silver Dep., 68:18-20.

Q. "Okay. You don't know exactly how these percentages work?"

A. "I don't, no. []." See, Silver Dep., 69:10-15.

Q. "So, you couldn't tell me as you sit here today whether these percentages are by weight or by volume, for example?"

A. "No, I could not." See, Silver Dep., 69:15-18.

Q. "Okay. Are any of these active ingredients controlled substances?"

A. "Controlled, meaning regulated, so to say?"

Q. "Yes."

A. "I am not certain. []." See, Silver Dep., 69:19-23.

Q. "Okay. And—but at the time you filed your application in 2006, you hadn't looked into whether you might need a license to obtain any of these chemicals?"

A. "No, I don't think so. See, Silver Dep., 70:10-14.

Q. "Are any of these active ingredients potentially irritants or potentially allergenic?"

A. "I'm not sure, you know. []." See, Silver Dep., 70:15-14.

Apart from the fact that "Document X" did not even contain a reference to the SUPER HERO mark, it is clear, based on Applicant's blank deposition responses, that neither this document nor Exhibit "B" can possibly support an alleged *bona fide* intent to use the SUPER HERO mark in connection with the applied-for goods. Instead, these documents support

Opposer's position that Applicant has never possessed such *bona fide* intent. Furthermore, Applicant's deposition responses seriously belie Applicant's alleged scientific background, as asserted in Applicant's Response Brief. *Ibid*, p. 5.

"Exhibit C" consists of a picture of what appears to be a can of "Synthetic Motor Oil" displaying the trademark "TEXASTEAL." It is not related to the SUPER HERO mark or the Class 3 products at issue; was never produced by Applicant; and is therefore irrelevant to this proceeding.

Finally, Applicant's litany of excuses regarding his deposition performance-- including distracting cell phone calls and emails during the deposition-- are nothing short of outrageous, and an insult to both the Board and the opposition procedure. Applicant requested and was granted a break to answer *one* cell phone call between 2:21 and 2:25 p.m., and this break is noted on the record. *See*, Silver Dep., 149:13-15. This break came well after the questioning concerning Applicant's knowledge of the term "SPF."


The bottom line is that Applicant has failed to provide a single document which can support his alleged *bona fide* intention to use the SUPER HERO mark in connection with the subject goods. Applicant admitted that he "has not taken any steps towards manufacturing, distributing, selling and/or promoting any products or services under the SUPER HERO trademark." (*See*, App. Supp. Interrog. Resp. at 27), and has not provided a reasonable excuse or explanation as to why. Therefore, Applicant's failure to come forward with any relevant or corroborating documentary evidence is sufficient to establish that he lacked a *bona fide* intention to use this mark in commerce, as required by Section 1(b) of the Trademark Act, 15 U.S.C. 1051(b). *See*, *Commodore Elecs. Ltd. v. CBM Kabushki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

CONCLUSION

For the reasons hereinabove set forth, Opposer respectfully requests that the Board issue an Order granting Opposer's Motion for Summary Judgment, sustaining its Opposition, and refusing registration to U.S. Application Ser. No. 91/176,744.

KENYON & KENYON LLP

Dated: July 22, 2009

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PROOF OF SERVICE

I hereby certify that true and complete copy of OPPOSER'S REPLY BRIEF IN
SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT has been served by mailing said
copy on July 22, 2009, via first class mail to:

Michael Craig Silver
64 Lincoln Drive
Sausalito, CA 94965


Michelle C. Morris